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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/987,190	11/13/2001	Kazutoh Takesako	1422-0502P	6479

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EXAMINER

BASKAR, PADMAVATHI

ART UNIT	PAPER NUMBER
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1645

5

DATE MAILED: 02/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/987,190

Applicant(s)

TAKESAKO ET AL.

Examiner

Padmavathi v Baskar

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-20 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ | 6) <input type="checkbox"/> Other: |

Restriction

1. Restriction to one of the following groups of invention is required under 35 U.S.C. 121:

I. Claims 1-6 drawn to nucleic acid encoding fungal antigen classified in class 536, subclass 23.7. Further restriction to one SEQ.ID.NO required (see paragraph # 3).

II. Claims 7 and 13-15 drawn to a process of producing fungal antigen from insoluble fraction. classified in class 435, subclass 41.

III. Claims 8-12 drawn to a process of producing fungal antigen from soluble fraction. classified in class 435, subclass 71.1.

IV. Claims 16-17 drawn to a method of stimulating immune response using antigen classified in class 424, subclass 184.1. Further restriction to one SEQ.ID.NO or one insoluble fungal antigen (see paragraphs # 3 and 4).

V. Claims 18-19 drawn to a method of suppressing allergic reaction to fungi classified in class 424, subclass 275.1 Further restriction to one SEQ.ID.NO or one soluble fungal antigen (see paragraphs # 3 and 4).

VI. Claim 20 drawn to a method of diagnosing a disease caused by fungi classified in class 435, subclass 7.22. Further restriction to one SEQ.ID.NO required or one insoluble fungal antigen or one soluble fungal antigen (see paragraphs # 3 and 4).

2. The inventions are distinct, each from the other because of the following reasons:

Group I is directed to DNA which consists of nucleic acids. Group II is directed to a process of producing fungal antigen obtained from insoluble fraction of the fungal cells. Group III is directed to another process of producing protein obtained from soluble fraction of fungal cells containing specific sugar groups. Thus Inventions II and III are different methods utilizing different steps to obtain different products with different structures. Groups IV-VI are different

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methods utilizing different products namely DNA, product obtained from insoluble fraction and product obtained from soluble fraction. These products are patentably distinct to each other with different structures having different biological properties. Thus, Inventions IV -VI are patentably distinct and different methods using patentably distinct and different biological reagents, different method steps that result in different outcome.

Distinct Inventions

3. If applicant elects group I, restriction to one of the following SEQ.ID.NO is also required under 35 USC 121.

Inventions SEQ ID NO: 1, 5, 7, 2, 6, and 8 unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions; represent structurally different polypeptides and the polynucleotides encoding them. Therefore, where structural identity is required, such as for hybridization or expression, the different sequences have different effects. Thus, each sequence is unique and patentably distinct since each sequence has a different structure with specific amino acid or nucleic acid and is identified by a specific SEQ.ID.NO. Restriction is deemed proper because these products appear to constitute patentably distinct inventions. These sequences are thus deemed to constitute independent and distinct inventions within the meaning of 35 U.S.C. 121. Absent evidence to the contrary, each such sequence is presumed to represent an independent and distinct invention, subject to restriction requirement pursuant to 35 U.S.C. 121 and 37 CFR 1.141.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed SEQ.ID.NO if group I is elected.

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4. If applicant elects group IV or V or VI, then applicant is required to elect any one of the product to be administered: One antigen as represented by SEQ.ID.NO 1, 5, 7, 2, 6, and 8 or one insoluble fungal antigen or one soluble fungal antigen. It is not clear whether insoluble antigen or soluble antigen corresponds to any SEQ ID NO. Therefore, applicant should point out the particular designation of the insoluble antigen or soluble antigen if they do not correspond to SEQ.ID.NOS. Applicant is required to specify the Fungi species (for example, Candida).

5. Inventions I and inventions IV/V/VI are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the nucleic acid of Group I can be used for making hybrid clones and need not be used in the inventions IV/V and VI.

6. Inventions I and II/III are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the process as claimed can be used to make bacterial antigens.

7. Should applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

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8. Concerning the burden of search, classification of subject matter is merely one indication of the burdensome nature of the search involved. The DNA database searches required by each of the sequences and the literature searches for each of the sequences, both of which are particularly relevant in this art, are not co-extensive and are much more important in evaluating the burden of search. Further, it is doubted that applicants would readily accept the rejection of one sequence by the application of art teaching another sequence. Clearly different searches and issues are involved in the examination of each group.

9. Because these inventions are distinct for the reasons given above, have acquired a separate status in the art as shown by their different classification, the literature and sequence searches required for each of the Groups are not required for another of the Groups, restriction for examination purposes as indicated is proper.

10. Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

11. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Padmavathi v Baskar whose telephone number is (703) 308-8886. The examiner can normally be reached on M-F (6:30A.M-4: 00 P.M.) First Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynette Smith can be reached on (703) 308-3909. The fax phone numbers for the

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organization where this application or proceeding is assigned are (703) 308-4242 for regular communications and (703) 308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

P. Baskar Ph.D
2/14/03

LYD
**LYNETTE R. F. SMITH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600**